

**REMARKS/ARGUMENTS**

Favorable reconsideration of the above-identified patent application, in light of the above amendments and the following remarks is respectfully requested. The presently pending claims are claims 1-20. Claims 1 and 8 have been amended.

The Examiner stated that the application currently names joint inventors and that the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Examiner also stated that the Applicant has an obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a). In response, the Applicant respectfully disagrees. The application only names one sole inventor, David M. Smith. A copy of the Filing Receipt is attached for your review.

The Examiner also rejected claims 1, 3-8, 10-12, 14, 16, 17, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,668,955 to deCiutiis et al. (deCiutiis) in view of U.S. Patent No. 5,898,756 to Manning et al. (Manning). The Examiner stated that deCiutiis discloses a series connected, auto-dialer and thus fails to disclose that the first digits are received via a "telephone network." The Examiner also stated that Manning teaches an auto-dialer capable of inserting an access code into the dialing sequence that is also connected in parallel to the subscriber line. Furthermore, the Examiner stated that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the parallel connection

arrangement as taught by the auto-dialer capable of inserting an access code into the dialing sequence to the serially connected, auto-dialer capable of inserting an access code into the dialing sequences as disclosed in deCiutiis. In addition, the Examiner stated that the suggestion/motivation for doing so would have been to decrease the ease of installation because of the difficulty of installation of serial-connected speed dialers and the transparency to the user using a parallel connected system.

In response, the Applicant has amended independent claims 1 and 8 to better differentiate Applicant's invention from the cited references. Claims 3-7 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Additionally, claims 10-12 depend from amended independent claim 8 and recite additional limitations in combination with the novel elements of claim 8. deCiutiis discloses an auto-dialer connected in series to a telephone line. In addition, deCiutiis discloses a controller for accessing service from one of a multiple number of service providers (Col. 2, lines 25-29). However, in order to accomplish the stated object of the deCiutiis invention, deCiutiis teaches the implementation of the controller as follows: "Once the system has been powered up and it has been determined that a call origination (outgoing call) is in progress, it is necessary for the access controller to totally disconnect the users phone from the phone line and switch in the access controller circuitry so that the access controller can listen for dialed digits without those digits actually being sent to the central office. Once switched in, the access controller must inspect the digits dialed by the user to determine if the outgoing call is a long distance call, and if so, whether the access code should be inserted or not" (Col. 14, lines 8-18).

The configuration disclosed in deCiutiis requires the use of a serial connection with a telephone line. With the controller disclosed in deCiutiis, in order to accomplished the stated objective of providing auto-dialing capability to multiple access codes, the connection must be in series. On the other hand, the Applicant's claimed invention utilizes a parallel connection to the telephone network. Unlike deCiutiis, the Applicant's invention provides a novel, simple and cost-effective way of utilizing an auto-dialer connected in parallel to a telephone network or telephone line to automatically dial the correct access code at the correct time. deCiutiis does not teach or suggest utilizing such a parallel connection. In addition, since deCiutiis cannot be implemented with a parallel connection, deCiutiis actually teaches away from utilizing a parallel connection.

In addition, the Applicant respectfully disagrees in that it would be obvious to one of ordinary skill to combine deCiutiis with Manning. For prior art references to be combined to render obvious a subsequent invention under Section 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q.2d at 1599. Hindsight is strictly forbidden. It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *Id.* At 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*,

23 U.S.P.Q.2d 1780, 1783 (Fed. Circ. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

deCiutiis does not provide any suggestion or motivation to combine its elements with those disclosed in Manning. As stated above, a serial connection is required to implement deCiutiis' controller on a telephone line. Thus, the combination of deCiutiis with Manning is improper.

Parallel connections with telephone lines and networks has been available for many years. Although parallel connections were available at the time of filing of the deCiutiis patent application, deCiutiis did not utilize a parallel connection in his system. In addition, although auto-dialers have been available, no one has utilized the configuration claimed by the Applicant. Although there has been a long felt need for such a configuration as claimed by the Applicant, no such device has ever been employed. Since such an auto-dialer system has been needed yet not employed, the Applicant respectfully disagrees that the Applicant's claimed invention would be an obvious modification of the combination of deCiutiis and Manning. Therefore, the withdrawal of the rejection and the allowance of claims 1, 3-8, 10-12, 14, 16, 17, 19, and 20 is respectfully requested.

The Examiner objected to claims 2, 9, 13, 15, and 18 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the elements of the base claim and any intervening claims.

In response, the Applicant has amended independent claims 1 and 8 to better differentiate Applicant's invention from the cited references. Claim 2 depends from amended independent claim 1 and recites additional limitations in combination with the novel elements of

claim 1. Claim 9 depends from amended independent claim 8 and recites additional limitations in combination with the novel elements of claim 8. In light of the amended claims and the arguments presented above, the withdrawal of the objection and the allowance of claims 2, 9, 13, 15, and 18 is respectfully requested.

CONCLUSION

For all the above reasons, the Applicant respectfully requests the reconsideration and withdrawal of the rejection and the allowance of claims 1-20.

Respectfully submitted,



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